

## REMARKS

Claims 48-51 and 53-62 were pending in the present application. By virtue of this response, claims 48, 50, 51 and 61 have been amended. Accordingly, claims 48-51 and 53-62 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

### **Response to Interview Summary**

After a telephone call with the Examiner in February of 2011, Applicants submitted amendments to be entered by an Examiner's amendment in order to place the pending application in condition for allowance. The Examiner performed a subsequent search and issued a new Office Action. The Examiner reported this activity to Applicants' attorney (Steve Giovannetti) via voice mail on March 16, 2011.

### **Rejections under 35 USC §103(a)**

**A.** Claims 48-51, 53-56, 58, 59 and 61 are rejected under 35 USC §103(a) as allegedly being unpatentable over Treyz et al. (US 6,587,835) in view of Trotta, Jr. (US 5,595,264) and further in view of Bednarek (US 6,956,868).

In response, Applicants respectfully disagree. It is well established that a *prima facie* case of obviousness requires that all the limitations of a claim must be considered and given weight. Applicants submit that the combination of art proposed by the Office Action fails to recite all of the requirements of the claims.

Applicants submit that contrary to the position taken in the Office Action, Bednarek does not teach or suggest the step of "setting up at least one customized search engine table to conduct a search by selecting a parameter of interest from the table, wherein the search engine table is set up by a user of the mobile device," according to independent claims 48-51. In contrast, Bednarek discloses an incentive system that may be combined with a merchant directory. Col. 64, ll. 41-45. A cellular position locator (CPL) system may be used as a directory service. Col. 67, ll. 34-39. One of the menu choices available to the user of the cellular position locator would be a merchant, vendor and service provider locator. Col. 67,

ll. 40-42. Also, a Merchant Information Database is provided which may be accessed by merchants to upload information pertaining to their goods or services. Col. 68, ll. 59-61. Additionally, figure 7A, cited by the Office Action, shows a menu summary that could be stored in the memory of a digital cellular phone. A 1-4 digit code for any particular function may be provided and the directory is one of the available menu choices. Col. 69, ll. 56-67.

As is clear from the above, Bednarek merely discloses a preset menu with a directory stored in a cellular phone. The menu and directory of Bednarek do not involve setting up a customized search engine table as claimed. Indeed, Bednarek does not teach or suggest “setting up at least one customized search engine table to conduct a search by selecting a parameter of interest from the table, wherein the search engine table is set up by a user of the mobile device.”

Additionally, the Office Action cites Bednarek for disclosing a customized incentive program (Fig. 9-1) where a site allows users to create a custom incentive program in three steps. The user, however, is presented with a list of sponsoring companies or categories of goods or services from which the user may choose. Col. 55, ll. 43- 67. The user is prompted to choose from one or more incentive programs offered by the sponsor and the user is then provided with details of the selected program. Col. 56, ll. 1-34. Again, Applicants submit that Bednarek’s disclosure of a customized incentive program does not teach or suggest the step of “setting up at least one customized search engine table to conduct a search by selecting a parameter of interest from the table, wherein the search engine table is set up by a user of the mobile device.”

Applicants also submit that Bednarek does not teach or suggest the additional elements of claim 50 (as amended) and claim 61, “wherein at least one flag may be set for regularly interrogating a site and notifying the user of an event triggering a need which has been expressed by the user.” The Office Action cites Bednarek, Col. 37, l. 66 to Col. 38, l. 7 as disclosing these elements. However, this passage of Bednarek merely discloses a data storage and memory unit of an incentive system that keeps track of information for each program participant. The unit also includes a base point award table and a redemption rate adjustment table that provide information as to the awards corresponding to certain participant actions. Col. 37, l. 66 to Col. 38, l. 7. Applicants submit that such disclosure

does not teach or suggest, "at least one flag that may be set for regularly interrogating a site and notifying the user of an event triggering a need which has been expressed by the user."

Thus, Applicants submit that the cited art fails to teach or suggest, either alone or in combination, all of the elements of the claims.

Furthermore, as recited in MPEP 2142, "the Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Applicants submit that the Office Action has provided no articulated reasoning for why a person of skill in the art would have found it obvious to combine the automated shopping system which utilizes a scanner, according to Trotta Jr. and the handheld computing device with scanner of Treyz with the merchant directory and incentive program of Bednarek. Thus, Applicants submit that the Office Action fails to establish a *prima facie* case of obviousness.

For at least the reasons given above, Applicants respectfully submit that independent Claims 48, 50 and 51, and the claims dependent therefrom, are therefore patentable over Treyz, Trotta, Jr. and Bednarek, alone or in combination.

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection under 35 U.S.C. §103.

**B.** Claim 57 is rejected under 35 USC §103(a) as allegedly being unpatentable over Treyz et al. (US 6,587,835) in view of Trotta, Jr. (US 5,595,264) in view of Bednarek (US 6,956,868) and further in view of Brophy (US 2003/0055974).

In response, Applicants submit that Treyz, Trotta, Jr. and Bednarek do not teach or suggest all of the elements of independent claims 48, 50 and 51 and Brophy fails to cure the defects of Treyz, Trotta, Jr. and Bednarek. Claim 57 depends from claim 48 and likewise is not rendered obvious by the cited art. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103.

**C.** Claim 60 is rejected under 35 USC §103(a) as allegedly being unpatentable over Treyz et al. (US 6,587,835) in view of Trotta, Jr. (US 5,595,264) in view of Bednarek (US 6,956,868) and further in view of Tanaka (US 7,008,456).

In response, Applicants submit that Treyz, Trotta, Jr. and Bednarek do not teach or suggest all of the elements of independent claims 48, 50 and 51 and Tanaka fails to cure the defects of Treyz, Trotta, Jr. and Bednarek. Claim 60 depends from claim 50 and likewise is not rendered obvious by the cited art. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103.

**D.** Claim 62 is rejected under 35 USC §103(a) as allegedly being unpatentable over Treyz et al. (US 6,587,835) in view of Trotta, Jr. (US 5,595,264) in view of Bednarek (US 6,956,868) and further in view of Davis et al. (US 6,965,682).

In response, Applicants submit that Treyz, Trotta, Jr. and Bednarek do not teach or suggest all of the elements of independent claims 48, 50 and 51 and Davis fails to cure the defects of Treyz, Trotta, Jr. and Bednarek. Claim 62 depends from claim 51 and likewise is not rendered obvious by the cited art. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103.

## CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the appropriate fee and/or petition is not filed herewith and the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with this filing to **Deposit Account No. 50-3973** referencing Attorney Docket No. **IPHLNZ00202**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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